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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/015,381
Filing Date: December 12, 2001
Appellant(s): BROWN ET AL.

H. Artoush Ohanian
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 14, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 31-41 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|--------------|-------------------|---------|
| 6,442,242 | McAllister et al. | 8-2002 |
| 2002/0184096 | Kawahara et al. | 12-2002 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 31-33, 35-37, 39 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by McAllister et al. (U.S. Patent No. 6,442,242).

Regarding claim 31, McAllister teaches receiving, at the voice processor 20, a spoken name for a call request from a caller telephone station (fig.1; col.5, lines 48-67, col.6, lines 1-3, 24-43, col.7, lines 1-11; 'voice processor 20' reads on the claim 'an intermediary device', 'spoken name' reads on the claim 'authenticated caller identity' and 'caller telephone station' reads on the claim 'origin device').

McAllister further teaches retrieving the subscriber-specific information for the caller name (fig.1, fig.2, fig.4; col.5, lines 48-67, col.6, lines 1-3, 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'subscriber-specific information' reads on the claim 'caller profile' and 'caller name' reads on the claim 'authenticated caller identity').

McAllister further teaches specifying the various services available to the subscriber on outgoing call according to the subscriber-specific information (fig.1, fig.2, fig.4; col.5, lines 48-67, col.6, lines 1-3, 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'various services available to the subscriber on outgoing call' reads on the claim 'a selection of services from among a plurality of services that are offered for said call request' and 'subscriber-specific information' reads on the claim 'caller profile').

Regarding claims 32 and 36, McAllister teaches that a caller name is identified by speech of the caller (fig.1, fig.2, fig.4; col.6, lines 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'caller name' reads on the claim 'authenticated caller identity' and 'identified

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by speech of the caller' reads on the claim 'authenticated by a voice utterance of said caller').

Regarding claims 33, 37 and 40, McAllister teaches retrieving the subscriber-specific information from a database within the voice processor 20 (col.6, lines 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'subscriber-specific information from a database' reads on the claim 'caller profile from a profile database' and 'voice processor 20' reads on the claim 'intermediary device').

Regarding claim 35, McAllister teaches the voice processor 20 communicatively connected to a telephone network (fig.1; col.4, lines 58-65, col.5, lines 39-43, 48-67, col.6, lines 1-3, 24-43, col.7, lines 1-11; 'the voice processor 20' reads on the claim 'an intermediary device' and 'public switched telephone network' reads on the claim 'telephone network').

McAllister further teaches receiving, at the voice processor 20, a caller name for a call request from a caller telephone station (fig.1, fig.2, fig.4; col.5, lines 48-67, col.6, lines 1-3, 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'voice processor 20' reads on the claim 'intermediary device', 'caller name' reads on the claim 'authenticated caller identity' and 'caller telephone station' reads on the claim 'origin device').

McAllister further teaches retrieving the subscriber-specific information for the caller name (col.6, lines 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'subscriber-specific information' reads on the claim 'a caller profile' and 'caller name' reads on the claim 'authenticated caller identity').

McAllister further teaches specifying the various services available to the subscriber on outgoing call according to the subscriber-specific information (col.6, lines

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24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'subscriber-specific information' reads on the claim 'caller profile' and 'various services available to the subscriber on outgoing call' reads on the claim 'a selection of services from among a plurality of services that are offered for said call request').

Regarding claim 39, McAllister teaches a database (col.6, lines 24-43; 'database' reads on the claim 'recording medium').

McAllister further teaches receiving a caller name for a call request from a caller telephone station (fig.1, fig.2, fig.4; col.5, lines 48-67, col.6, lines 1-3, 24-43, col.7, lines 1-11, 18-32, 55-67, col.8, lines 1-10; 'caller name' reads on the claim 'authenticated caller identity' and 'caller telephone station' reads on the claim 'origin device').

McAllister further teaches retrieving the subscriber-specific information for the caller name (col.6, lines 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'subscriber-specific information' reads on the claim 'a caller profile' and 'caller name' reads on the claim 'authenticated caller identity').

McAllister further teaches specifying the various services available to the subscriber on outgoing call according to the subscriber-specific information (col.6, lines 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10; 'subscriber-specific information' reads on the claim 'caller profile' and 'various services available to the subscriber on outgoing call' reads on the claim 'a selection of services from among a plurality of services that are offered for said call request').

2. Claims 34, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister et al. (U.S. Patent No. 6,442,242) and in view of Kawahara et al. (U.S. Pub. No. 2002/0184096).

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Regarding claims 34, 38 and 41, McAllister fails to teach "retrieving said caller profile from a systems management server". Kawahara teaches retrieving the user personal information from the user management server (page 13, paragraph 0239; 'user personal information' reads on the claim 'caller profile' and 'user management server' reads on the claim 'systems management server'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McAllister to allow retrieving the caller profile from the systems management server as taught by Kawahara. The motivation for the modification is to have doing so in order to provide various services as desired by the caller.

(11) Response to Argument

Issue I

On page 5 of the Appeal Brief, Applicant contends that McAllister et al. does not disclose the claimed limitation of specifying telephone service for a particular caller as claimed in independent claim 31.

The Examiner respectfully disagrees with Applicant for the argument. The claimed limitation is recited in the preamble of the claim. The body of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness and therefore, the preamble does not usually limit the claim.

Issue II

On page 5, third paragraph of the Appeal Brief, regarding claim 31, the Applicant further contends that McAllister does not disclose "retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a

It also appears that there is no specific teaching of 'telephone services' in the disclosure. For example, Page 16, lines 4-11 "teaches 'preferred' and 'specialized' service."

In particular, the 'shopping preference' and 'specialized service' appear to be equivalent to McAllister's 'Product related Service' and 'specialized service' to 'new battery replacement service'.

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plurality of services that are offered for said call request according to said caller profile”.

The examiner disagrees with this argument. McAllister does disclose retrieving a subscriber-specific information (i.e., caller profile) for the authenticated caller identity (col.7, lines 18-32, 55-67, col.8, lines 1-10); specifying the various services available to the subscriber on outgoing call (i.e., a selection of services from among a plurality of services that are offered for said call request) according to the caller profile (fig.1, fig.2, fig.4; col.5, lines 48-67, col.6, lines 1-3, 24-43, col.7, lines 18-32, 55-67, col.8, lines 1-10). Thus the rejection of the claim in view of McAllister remain. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the examiner has given the claim language its broadest reasonable interpretation.

Regarding claims 35 and 39 are rejected for the same reasons as discussed above with respect to claim 31.

Issue III

On page 10 of the Appeal Brief, Applicant contends that McAllister nor Kawahara disclose the claimed limitation of specifying telephone service for a particular caller as claimed in independent claim 31.

The Examiner respectfully disagrees with Applicant for the argument. The claimed limitation is recited in the preamble of the claim. The body of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness and therefore, the preamble does not usually limit the claim. Although the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the examiner has given the claim language its broadest reasonable interpretation.

In response to applicant's argument on page 11 that there is no suggestion or motivation to combine McAllister and Kawahara, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, McAllister provides the suggestion for one of ordinary skill in the art will be able to effect various changes, substitutions of equivalents, and various aspects of the invention as broadly disclosed herein in col.9, lines 1-4. Furthermore, since McAllister suggests of retrieving the user-specific information (i.e., caller profile) from the database in col. 6, lines 30-33 and Kawahara suggests of retrieving the user personal information (i.e., caller profile) from the user management server (i.e., systems management server) as shown in page 13, paragraph 0239 then the combination of McAllister and Kawahara provides reason for one of ordinary skill in the art to want to use user management server for retrieving the user personal information so that the callers of McAllister can get various services as desired by them.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

M.E.

September 2, 2004

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